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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,293	08/14/2006	Debbie Stevens-Wright	B1075.71014US01	1875
23628 7590 04/11/2011 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER				
GOOD, SAMANTHA M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/551,293

**Applicant(s)**

STEVENS-WRIGHT ET AL.

**Examiner**

SAMANTHA GOOD

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7, 11-13, 16, 17, 19 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-7, 11-13, 16, 19 and 33 is/are rejected.
- 7) ☒ Claim(s) 4 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

Claims 4 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3, 5-7, 11, 16, and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al (5,178,620).**

**As to claim 1**, Eggers discloses a catheter in Fig. 3 comprising: a longitudinal catheter shaft 1 for positioning an ablation electrode 3 within a patient's body; and an ablation electrode 2 disposed on the shaft (e.g. on the end) and having an outer ablating surface (see Fig. 3), wherein the electrode is convertible from a first configuration in which the electrode outer ablating surface has a first axial size and a first radial size to a second configuration in which the electrode outer ablating surface has a second axial size and maintains the first radial size since the electrode 2 advances (col. 6, lines 24-26); wherein the ablation electrode comprises a first electrode portion 3 and a second electrode portion 2 which are in electrical contact with each

other (Col. 5, lines 50-68; Figure 1), the first electrode portion having an outer ablating surface (see Fig. 3), and the second electrode portion having a length and being moveable in the axial direction of the catheter since the electrode 2 advances (col. 6, lines 24-26), wherein in the first configuration more of the second electrode portion length is contained within the first electrode portion than in the second configuration since when the electrode 2 advances more of electrode 2 is exposed (e.g. 2<sup>nd</sup> configuration, col. 6, lines 24-26). Note that the claim does not specifically require the electrode to coaxially surround the shaft, but only be "disposed on the shaft" which is broad.

**As to claim 3**, in the first configuration, the second electrode portion length is capable of being fully contained within the first electrode portion (e.g. may be pulled back).

**As to claim 5**, Eggers discloses a pull wire is connected to the second electrode portion since the electrode 2 may be connected to a guide wire (col. 4, lines 63-65).

**As to claim 6**, Eggers discloses the ablation electrode is a ring electrode (see Fig. 3).

**As to claim 7**, Eggers discloses the first electrode portion and the second electrode portion are cylindrical (see Fig. 3).

**As to claim 11**, Eggers discloses a catheter in Fig. 3 comprising: a longitudinal catheter shaft 1 for positioning an ablation electrode within a patient's body; and an ablation electrode 2 and 3 having an electrode length and disposed on the shaft, the electrode having a continuous outer ablating surface area with an outer ablating surface

area length (see Fig. 3), and the electrode having portions which are movable relative to one another since electrode 2 may be advanced (col. 6, lines 24-26) and which stay in electrical contact with one another (via electrical lead, see col. 5, lines 51-54); wherein the continuous outer ablating surface area length is adjustable since electrode 2 may be advanced (col. 6, lines 24-26); the ablation electrode length is adjustable since electrode 2 may be advanced (col. 6, lines 24-26); and the electrode is substantially comprised of metal (see claim 27 in the patent).

**As to claim 16,** Eggers discloses a catheter comprising: a longitudinal catheter shaft configured to position an ablation electrode within a patient's body, wherein a first ablation electrode portion and a second ablation electrode portion are mounted on the catheter shaft (see Fig. 3); the first ablation electrode portion 3 having an outer ablating surface configured to emit electrical energy (see Fig. 3); the second ablation electrode portion having an outer ablating surface configured to emit electrical energy since it is an electrode (col. 4, lines 60-65); wherein the second ablation electrode portion 2 is moveable from a first position substantially inside the first ablation electrode portion 3 to a second position substantially outside the first ablation electrode portion 3 since it advances (col. 6, lines 24-26); and the first ablation electrode portion 3 and the second ablation electrode portion are electrically connected (col. 5, lines 51-54).

**As to claim 19,** Eggers discloses a pull wire configured to move the second electrode portion since the electrode 2 may be connected to a guide wire (col. 4, lines 63-65).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al (5,178,620) as applied to claim 11 above, and further in view of Eggers (5,810,764).**

**As to claim 12**, Eggers '620 does not expressly teach that the electrode is substantially comprised of at least one of platinum, silver, gold, chromium, aluminum and tungsten. However, Eggers '764 teaches that electrodes for ablation comprise electrically conducting materials such as alloys containing one or more of platinum, chromium, aluminum or tungsten (col. 22, lines 49-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the electrode of Eggers '620 such that it substantially comprised of at least one of platinum, silver, gold, chromium, aluminum or tungsten since suitable metallic materials for an ablation electrode is recognized in the art, as exemplified by the teachings of Eggers '764 (col. 22, lines 49-53).

**As to claim 13**, Eggers '620 does not expressly teach that the electrode is substantially comprised of a combination of at least two of: platinum; silver; gold; chromium; aluminum and tungsten. However, Eggers '764 teaches that electrodes for ablation comprise electrically conducting materials such as alloys containing one or more of platinum, chromium, aluminum or tungsten (col. 22, lines 49-53). It would have

been obvious to one of ordinary skill in the art at the time of the invention to implement the electrode of Eggers '620 such that it substantially comprised of a combination of at least two of platinum, silver, gold, chromium, aluminum or tungsten since suitable metallic combinations for an ablation electrode is recognized in the art, as exemplified by the teachings of Eggers '764 (col. 22, lines 49-53).

**Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al (5,178,620) as applied to claim 11 above, and further in view of Danek et al (6,411,852).**

**As to claim 33,** Eggers discloses the first electrode portion is in electrical contact with an electrical lead, and the second electrode portion is in electrical contact with an electrical lead (col. 5, lines 51-54), which have the same reference number 16. Eggers fails to expressly teach whether the electrical leads are the same or different. Danek et al teaches an analogous catheter comprising an ablation electrode having a first electrode portion and a second electrode portion which are in electric contact with each other wherein the first electrode portion (for example electrode 38 shown in Figures 5) is in electrical contact with an electrical lead, and the second electrode portion (for example electrode 38 shown in Figures 5) is in electrical contact with the same electrical lead (Col. 8, lines 13-37; Figures 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the first and second electrode portion, as taught by Eggers et al, to be in electrical contact with the same electrical lead, as taught by Danek et al, in order to be able to operate in a monopolar

mode in order to vary the pattern of energy delivery desired (Col. 8, lines 15-18 and lines 25-27).

### ***Response to Arguments***

Applicant's arguments filed February 8, 2011 have been fully considered but they are not persuasive. Eggers et al teaches wherein the electrode portion 2 and electrode portion 3 are electrically connected because they are attached to the same electrical source (10) (Figure 1). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., being connected to a same electrical lead, being electrically conductive contact with one another, or being connected to the same pole of a power source) are not recited in any of the independent rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The newly added claim limitation in claim 1 of "which are in electrical contact with each other" raised new considerations that warranted new grounds of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMANTHA GOOD whose telephone number is (571)270-7480. The examiner can normally be reached on Monday - Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G./  
Examiner, Art Unit 3739

/Michael Peffley/  
Primary Examiner, Art Unit 3739